

REMARKS

Claims 1-32 are pending and at issue in the above identified patent application. Of the claims at issue, claims 1, 14, and 28 are independent. The examiner alleges claims 1-32 include two inventions. In particular, the examiner identifies claims 1-27 as one invention and claims 28-32 as another invention. Additionally, the examiner alleges claims 1-32 are directed to six distinct Species. Specifically, the examiner requires a Species election between figures 1 through 4 and 13 (Group III), figures 5 and 6 (Group IV), figures 7 and 8 (Group V), figure 9 (Group VI), figure 10 (Group VII), and figures 11 and 12 (Group VIII). As set forth in detail below, without denying that the claims are patentably distinct, the applicant *traverses* this restriction requirement and species election for at least the following reasons.

Invention Restriction (Groups I and II)

The M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803).

Turning to whether the inventions are independent or distinct as claimed, as noted by the examiner, M.P.E.P. § 806.05(e) states that “Process and apparatus for its practice can be shown to be distinct inventions, if...the apparatus *as claimed* can be used to practice another materially different process.” The examiner maintains that the apparatus, *as claimed*, can be used with “a torque sensor on a cable spool to measure resistance on the cable spool,” and then discontinue “the movement of the door in response to a [change] of torque.” However, such an alternate process cannot be fairly characterized as practicing the apparatus *as claimed*. In particular, despite the examiner’s suggestion that a torque sensor measures resistance, the applicant assumes the examiner meant that the torque sensor measures a

torque. Moreover, employing a torque sensor is not consonant with independent claim 1, which recites, *inter alia*, a sensor to sense tension. Additionally, because the apparatus, *as claimed*, recites a sensor to sense tension, a torque sensor would be superfluous in view of the examiner's hypothetical process.

Turning to whether any burden, much less a serious burden exists for the examiner, the applicant maintains that regardless of whether the examiner may conclude that the claims are independent or distinct, the examiner fails to demonstrate that a serious burden would be placed on the examiner if election were not required. Accordingly, the applicant respectfully submits that no matter what the rationale for independent or distinct invention, there can be no serious burden upon the examiner in reviewing all of the claims simultaneously, because the examiner will likely be searching a single class/subclass in full (i.e., class 49) anyway in reference to any elected one of the invention. Moreover, it cannot be fairly alleged that a search of two subclasses within class 49 is a serious burden on the examiner.

In fact, the applicant's cursory search of U.S. patents with a current classification of class 49/subclass 506 on the United States Patent and Trademark Office website reveals over one hundred and fifty patents, wherein at least the first fifteen patents included a field of search including a plurality of additional subclasses and/or a plurality of separate classes¹. For example, the applicant submits that all of U.S. Patent Nos. 7,047,693, 6,840,012, and 6,823,629 are currently classified in class 49/subclass 506 and have a field of search including between five and thirteen subclasses searched therein. Of course, the applicant welcomes any helpful explanation regarding reasons why the instant application exhibits a serious burden while the aforementioned patents apparently do not include such a burden, despite including numerous classes and/or subclasses therein.

¹ Applicant only reviewed U.S. Patent Nos. 7,082,722, 7,076,920, 7,051,479, 7,047,693, 7,025,004, 6,966,151, 6,928,735, 6,925,942, 6,892,496, 6,877,280, 6,860,067, 6,854,215, 6,851,223, 6,840,012, and 6,823,629.

Therefore, for at least the reasons that the examiner's torque sensor hypothetical fails to read on the apparatus as claimed, and that it cannot be fairly alleged that a serious burden exists, the applicant respectfully requests the withdrawal of the restriction requirement.

Species Election(s) (Groups III through VIII)

Turning now to the Species election, the applicant notes that the examiner has not provided any rationale or information regarding the reason for election of Groups III through VIII, and therefore, the Species election requirement is necessarily improper and must be withdrawn. In particular, the examiner simply concludes that "this application contains claims directed to the following patentably distinct species," without providing any reasons to support that conclusion.

It is well established, however, that the first criteria for making a proper restriction (including a Species restriction) is that the inventions must be independent or distinct. To that end "[e]xaminers must provide reasons and/or examples to support conclusions..." (M.P.E.P. § 803; emphasis added).

In the present action, the examiner has provided no reason and/or example as to why each of the alleged Species is independent or distinct. The examiner has provided nothing more than simple nomenclature to various combinations of Figures and has failed to define those groups, much less explain how such groups may be interpreted as distinct. As such, the Office action does not put the applicant in a position to meaningfully address the election requirement because the action is devoid of rationale regarding the required criteria for restriction. Therefore, the Office action clearly fails to meet the first requirement of M.P.E.P. § 803 and, on this basis alone, the Species election requirement must be withdrawn.

Turning to whether any burden exists for the examiner, the applicant observes that the examiner has failed to identify any burden with respect to the species election requirement,

much less any serious burden. Nonetheless, the applicant respectfully submits that no matter what the rationale for the species election, there can be no serious burden upon the examiner in reviewing all of the claims and associated figures simultaneously.

Conclusion

In view of the invention and Species restriction and any alleged burden, if there is any serious burden in the present application, it is on the assignee of this application as a result of this invention and Species restriction requirement. Unless the restrictions are withdrawn, the assignee must not only prosecute as many as twelve separate applications (i.e., six Species for each alleged invention), which multiplies the cost and time of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain twelve different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

The Office action fails meet any of the requirements of M.P.E.P. § 803. In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803; emphasis added). Therefore, the applicant requests that the requirement for invention restriction and the requirement for Species election be withdrawn.

Election under 37 C.F.R. § 1.143

Subject to the traversal of the restriction requirement and in accordance with the requirements of 37 C.F.R. § 1.143, the applicant hereby provisionally elects the invention

from Group II (claims 28-32) and the Species from Group III (Figures 1 through 4 and 13).
Claims 28-32 each read upon the elected invention of Group II and species of Group III.

The applicant further submits that independent claim 28 is generic to all of Groups III-VIII. In particular, each of the figures of Groups III-VIII include sensing tension in the flexible elongate member, as recited in claim 28.

In making this provisional election, the applicants do not intend to abandon the scope of non-elected claims, but may pursue the non-elected claims in a divisional application if the restriction requirement is not withdrawn upon reconsideration.

Reconsideration of the application and allowance thereof are respectfully requested.
If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,
Hanley, Flight & Zimmerman, LLC
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606

Dated: August 7, 2006

/Keith R. Jarosik/
Keith R. Jarosik
Reg. No. 47,683
Attorney for Applicant
(312) 580-1020